

REMARKS

I. Introduction

For the reasons set forth below, Applicant respectfully submits that all pending claims are patentable over the cited prior art references.

II. The Rejection Of Claims 1 and 5 Under 35 U.S.C. § 102

Claims 1 and 5 are rejected under 35 U.S.C. § 102 as being anticipated by USP No. 6,587,454 to Lamb. Applicant respectfully traverses this rejection for at least the following reasons.

A. Lamb Does Not Disclose Coupling A Media Access Controller To A Processor Core Through A Bus

Claim 1 recites in-part a Voice-over-Internet Protocol processor core, a bus and one or more IEEE 802.3 media access controllers (MACs) coupled to the Voice-over-Internet Protocol processor core through the bus.

In the pending rejection, the Examiner broadly reads the MAC/DSP circuits 61 of Lamb as both the claimed Voice-over-Internet Protocol processor core and media access controller, and the node core logic 60 as the claimed bus.

However, such a reading of Lamb still does not provide the claimed subject matter, because Lamb expressly discloses that the media access controller MAC resides within the MAC/DSP circuit 61 (see, col. 6, lines 25-26). Accordingly, it is clear that the media access controller MAC is structurally positioned inside the MAC/DSP circuits 61, and is not structurally coupled to the MAC/DSP circuits 61 through the node core logic 60 as suggested by the Examiner.

As anticipation under 35 U.S.C. § 102 requires that each element of the claim in issue be found, either expressly described or under principles of inherency, in a single prior art reference, *Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 218 USPQ 781 (Fed. Cir. 1983), and at a

minimum, Lamb fails to disclose or suggest the foregoing claim elements, it is clear that Lamb does not anticipate claim 1, or any of the claims dependent thereon.

III. The Rejection Of Claim 6 Under 35 U.S.C. § 103

Claim 6 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Lamb in view of USP No. 6,526,131 to Zimmerman. Applicant respectfully traverses this rejection for at least the following reasons.

A. Lamb and Zimmerman Do Not Disclose Coupling A Media Access Controller To A Processor Core Through A Bus

Claim 6 recites in-part a single-chip Voice-over-Internet Protocol network processor, a flexible peripheral interconnect (FPI) bus, and one or more IEEE media access controllers (MACs) integrated onto the single chip through the FPI bus.

In the pending rejection, the Examiner maintains that Lam discloses these claimed features as those provided with respect to claim 1. However, Applicant respectfully reiterates that Lamb expressly discloses that the media access controller MAC resides within the MAC/DSP circuit 61 (see, col. 6, lines 25-26) so that the media access controller MAC is structurally positioned inside the MAC/DSP circuits 61. Accordingly, the media access controller MAC of Lamb does not require external components to provide the necessary coupling to the MAC/DSP circuits 61, let alone utilize a specific FPI bus to do so.

The Examiner has not shown that Zimmerman discloses any media access controller or FPI bus, let alone a system that specifically couples such a controller to the MAC/DSP circuits 61 of Lamb using a FPI bus. Consequently, neither Lamb nor Zimmerman (either alone or in combination) can render claim 6 obvious, and the Examiner has not made a *prima facie* showing of obviousness.

B. Proposed Modification Renders Lamb Inoperable For Its Intended Purpose

It is respectfully submitted that the proposed modification would render Lamb inoperable for its intended purpose. The Examiner is directed to **M.P.E.P § 2143.01** under the sub-title “The Proposed Modification Cannot Render the Prior Art Unsatisfactory for its Intended Purpose”, which sets forth the applicable standard:

If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is **no suggestion or motivation** to make the proposed modification. (citing *In re Gordon*, 221 USPQ 1125 (Fed. Cir. 1984)).

In the instant case, the upstream packet network port 51 (alleged communication port) of Lamb is configured to connect to the network medium 54 in a manner that a power decoupler 55 also can be coupled to the medium 54 through the upstream packet network port 51 for generating and supplying power to the components of the adaptor 50 and the telephone 10 (see, col. 5, lines 50-55). Accordingly, not only is there no disclosed need or desire for modifying Lamb to replace the upstream packet network port 51 with a USB port, doing so would effectively cut off all power supplied to the adaptor 50 and every component housed in the adaptor 50, including the upstream packet network port 51, downstream packet network port 52, downstream telephone port 53, MAC/DSP circuits 61 and node core logic 60.

It is therefore respectfully submitted that, pursuant to M.P.E.P § 2143.01, “there is no suggestion or motivation to make the proposed modification.” It is important to note that upstream packet network port 51 is not designed to provide an interface between the node core logic 60 and USB-compatible devices, but rather, is designed to behave as a port for standard repeaters (see, col. 6, lines 4-6).

C. Asserted Purpose For Making Combination Not Achieved By The Proposed Combination

It is respectfully submitted that the proposed combination is improper because the prior art does not suggest such a modification to Lamb and there is no objective evidence on the record that suggests the desirability of the proposed combination. It is respectfully submitted

that there is no rationale or motivation, derived from the prior art, for modifying Lamb in the manner set forth by the pending rejection. In fact, the asserted motivation in the Office Action (i.e., ... "to provide the capability for the VoIP processor to support USB ports because it would allow the VoIP telephone to connect to some USB compatible peripheral devices such as scanners and printers") for making the combination is not achieved by the structural interpretation made by the rejection. In particular, the adaptor 50 of Lamb is not intended to provide any interface or circuitry for connection with any USB devices, because these USB devices can readily be connected via the host computer (e.g., 40/17, Figs 1 and 2 of Lamb). Accordingly, even if the upstream packet network port 51 of Lamb is replaced with a USB port, the adaptor 50 would still fail to connect to USB compatible devices as suggested by the Examiner, as the adaptor 50 lacks appropriate circuitry for achieving this purpose. As such, the proposed combination is not commensurate with the asserted motivation.

D. Motivation To Replace Upstream Packet Network Port of Lamb Not Derived From Prior Art

Further, it is submitted that the modification of the upstream packet network port of Lamb is not derived from Zimmerman. The relied on teachings of Zimmerman are directed to a connectivity box-to-peripheral connect USB interface 31 connection rather than the claimed VoIP processor-to-USB connection.

In this regard, Applicant notes that the Examiner reads the connectivity box of Zimmerman as a processor. However, it is clear that the connectivity box is not a Voice-over-Internet Protocol network processor. Particularly, it should be noted that the connectivity box of Zimmerman does not accept VoIP calls (and therefore cannot be interpreted as an VoIP processor) as alleged on page 6 of Office Action, because the cited section (i.e., col. 22, lines 24-26) is directed to sending and transforming a VoIP call into a normal PSTN call **prior to** being received at the connectivity box 11. That is, the connectivity box, at best, accepts PSTN calls, and certainly does not accept VoIP calls.

Accordingly, at best, any teaching derived from Zimmerman, absent hindsight, would necessarily be attributable to a connection between a connectivity box including a processor subsystem and memory, and scanners or printers. As such, any potential modification of Lamb based on Zimmerman would at best be directed to the connection between a normal processor (such as that of a computer) and USB devices, a compatibility in which the computer 40 of Lamb already possesses.

It is respectfully submitted that the Examiner's extension of the teachings of Zimmerman to connecting a VoIP processor to one or more USB compatible devices is not commensurate with any rationale derived *from the prior art*. Accordingly, it is respectfully submitted that the proposed combination is based solely on improper hindsight reasoning whereby the Examiner selected bits and pieces of the prior art and used only Applicant's specification as a guide to reconstruct the claimed invention.

E. Even If Combined, Lamb and Zimmerman Do Not Teach or Suggest One Or More USB Ports Operable To Provide An Interface Between The Voice-over-Internet Protocol Network Processor And One Or More USB Compatible Devices

While Applicant believes that the combination of Lamb and Zimmerman is improper as discussed above, even if combined, the combination does not teach or suggest Applicant's claimed limitations.

Applicant respectfully submits that claim 6 does not merely recite one or more USB ports, but also recites one or more USB ports operable to provide an interface **between the Voice-over-Internet Protocol network processor and one or more USB compatible devices** without having to provide external interfacing circuitry.

Specifically, in order to support the allegation that the upstream packet network port 51 of Lamb can be replaced with a USB port, the USB port of Zimmerman should at least be connected to a VoIP processor. However, noting that the connectivity box of Zimmerman is not a VoIP processor for reasons discussed above, even if Lamb and Zimmerman are combined in the manner suggested by the Examiner, the proposed combination still fails to arrive at the

claimed invention, because the USB port of Zimmerman does not “provide an interface **between the Voice-over-Internet Protocol network processor** and one or more USB compatible devices without having to provide external interfacing circuitry,” as required in claim 6.

At best, the Examiner has attempted to show only that the elements of the claimed invention are *individually* known (e.g., a USB port, a processor and USB compatible devices) without providing a *prima facie* showing of obviousness that the *combination* or the *inter-relationship* (emphasis added) of these elements recited in the claims is known or suggested in the art.

That is, the proposed combination fails to arrive at the claimed invention, because the Examiner has not provided factual evidence to show the *inter-relationship* between the alleged VoIP processor and the alleged USB port.

Absent this teaching, it is respectfully submitted that neither Lamb nor Zimmerman, alone or in combination, disclose the foregoing claimed limitation.

IV. **The Rejection Of Claim 10 Under 35 U.S.C. § 103**

Claim 10 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Lamb in view of Zimmerman, and further in view of USP No. 6,658,027 to Kramer. Applicant respectfully traverses this rejection for at least the following reasons.

With respect to claim 10, the Examiner has rejected the foregoing claims based on the same reasons set forth in the rejection to claim 6. Accordingly, Applicant respectfully submits that the reasons discussed above with respect to claim 6 are also applicable to the rejection of claim 10, and claims dependent thereon.

As Kramer neither disclose a VoIP processor that includes one or more IEEE 802.3 media access controllers (MACs) nor suggest a USB port operable to provide an interface between a VoIP processor and a USB compatible device, consequently, neither Lamb, Zimmerman nor Kramer (either alone or in combination) can render claim 10 obvious, and the rejection has not made a *prima facie* showing of obviousness.

V. **All Dependent Claims Are Allowable Because The Independent Claims From Which They Depend Are Allowable**

Under Federal Circuit guidelines, a dependent claim is neither anticipated nor rendered obvious if the independent claim upon which it depends is allowable because all the limitations of the independent claim are contained in the dependent claims, *Hartness International Inc. v. Simplimatic Engineering Co.*, 819 F.2d at 1100, 1108 (Fed. Cir. 1987). Accordingly, as independent claims 1, 6 and 10 are patentable for the reasons set forth above, it is respectfully submitted that all claims dependent thereon are also in condition for allowance.

VI. **Conclusion**

By responding in the foregoing remarks only to particular positions taken by the Examiner, the Applicant does not acquiesce with other positions that have not been explicitly addressed. In addition, Applicant's arguments for the patentability of a claim should not be understood as implying that no other reasons for the patentability of that claim exist.

Accordingly, it is urged that the application is in condition for allowance, an indication of which is respectfully solicited.


If there are any outstanding issues that might be resolved by an interview or an Examiner's amendment, the Examiner is requested to call Applicant's attorney at the telephone number shown below.

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To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 06-1050 and please credit any excess fees to such deposit account.

Respectfully submitted,



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